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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

LEFKOWITZ, SUMATI

| ART UNIT | PAPER NUMBER |
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2112

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/773,026

Applicant(s)

THOMPSON ET AL.

Examiner

Sumati Lefkowitz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-14 and 16-19 are pending.

Suspension of Action

2. The suspension of action issued by the Office on 4/2/04 due to the unavailability of a reference has been terminated. The reference is now available as 6,748,515 to Hendrickson et al. and confirms the entitlement of the Bresemann et al. reference (US 2003/0005274A1) to the priority date of July 17, 2000, as the portions relied upon by the examiner in the Bresemann reference are contained, verbatim, in the now available Hendrickson reference, thereby making the Bresemann reference a valid reference against the claimed invention.

Specification

3. The abstract of the disclosure is objected to because
 - it fails to mention that the lookup table results in a reduction of number of components and cost required to provide product IDs to USB devices, since the same lookup table can be implemented in numerous USB devices, with the product ID being selected from the lookup table to define/configure the USB device as a specific type of device (see last page of specification)Correction is required. See MPEP § 608.01(b).

Claim Objections

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4. Applicant is advised that should claims 16 and 17 be found allowable, claims 18 and 19 will be objected to under 37 CFR 1.75 as being substantial duplicates, respectively, thereof.

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 7, 8, 14, 16, 21, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsai et al., 6,192,420 (hereinafter Tsai).

As to claims 1, 7, 8, 14, 16, 18, 21, and 22, Tsai discloses a USB device, comprising a lookup table in fixed (i.e., not removable) electronically readable medium comprising a plurality of product identification (i.e., PID) entries, an electronically readable index that selects one of the plurality of product identification entries and vendor identification (i.e., VID) information stored in a location separate from the index (note abstract, column 1, line 39 – column 3, line 5 and column 4, line 62 – column 4, line 6, wherein the fact that the index is stored in memory 121 and the VID is stored in memory 122 reads on the vendor id being stored in a location separate

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from the index), further comprising vendor identification information in fixed electronically readable medium (i.e., memory 122), wherein the vendor identification information and the lookup table are located on an integrated circuit (note column 1, lines 6-8 and Figures 1 and 2).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 2, 4-6, 9-10, and 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai et al., 6,192,420 (hereinafter Tsai) in view of Bresemann et al., US 2003/0005274 A1 (hereinafter Bresemann).

a. As to claims 2, 4, 5, 9, 10, 12, Tsai fails to disclose that the electronically readable

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index is set by connections on a printed circuit board, that the electronically readable index is set by the logic state of pins on an ic wherein those pins on the ic also have a function different from setting the electronically readable index, or that the electronically readable index is set by connections internal to an ic also containing the lookup table.

Bresemann discloses that the electronically readable index is set by connections on a printed circuit board (note paragraph [0022], that the electronically readable index is set by the logic state of pins on an ic wherein those pins on the ic also have a function different from setting the electronically readable index (note paragraph [0033]), and that the electronically readable index is set by connections internal to an ic also containing the lookup table (note paragraph [0034]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to set the index by any equivalent, alternative means, such as connections on a printed circuit board, the logic state of pins on an ic, or connections internal to an ic, as Bresemann teaches, in the system of Tsai so as to take advantage of whatever resources are available to the system designer in order to allow the lookup table to be indexed for id information.

b. As to claims 6, 13, 17, and 19, Tsai fails to disclose that the vendor id information comprises a vendor identification number and a vendor identification string.

Bresemann discloses that the vendor id information comprises a vendor identification number and a vendor identification string (note paragraphs [0021, 0022, 0025, 0033-0034].

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of a vendor id number and string, as Bresemann teaches, in the system of Tsai

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so as to allow for a wide variety of different software and/or hardware configurations, as Bresemann teaches in paragraph [0021].

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai et al., 6,192,420 (hereinafter Tsai) in view of Baldwin et al., 5,042,265 (hereinafter Baldwin).

As to claim 3, Tsai fails to disclose that the electronically readable index is set by jumper connections.

Baldwin discloses the use of jumpers as an index into a table (note column 6, line 44 – column 9, line 31) to configure a system to operate in one of a plurality of modes/states.

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of jumpers to index a table in order to configure the operation of a system, as Baldwin teaches, in the system of Tsai so as to allow for the flexible selection of one of a plurality of operation modes.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai et al., 6,192,420 (hereinafter Tsai) in view of Bresemann et al., US 2003/0005274 A1 (hereinafter Bresemann), as applied to claims 2, 4-6, 9-10, and 12-19 above, and further in view of Baldwin et al., 5,042,265 (hereinafter Baldwin).

As to claim 11, Tsai and Bresemann fail to disclose that the electronically readable index is set by jumper connections.

Baldwin discloses the use of jumpers as an index into a table (note column 6, line 44 – column 9, line 31) to configure a system to operate in one of a plurality of modes/states.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of jumpers to index a table in order to configure the operation of a system, as Baldwin teaches, in the system of Tsai and Bresemann so as to allow for the flexible selection of one of a plurality of operation modes.

11. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai et al., 6,192,420 (hereinafter Tsai) in view of Lambeth et al., 6,023,736 (hereinafter Lambeth).

Tsai fails to disclose that the electronically readable medium is a ROM. Lambeth discloses that the electronically readable medium is a ROM (note column 6, line 65 – column 7, line 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of a ROM to as the electronically readable medium storing the id info, as Lambeth teaches, in the system of Tsai so as to prevent the ids from inadvertently being changed and causing system inoperation or failure.

Response to Arguments

12. Applicant's arguments filed 9/17/03 regarding the improper use of Bresemann as prior art against the claimed invention have been fully considered but they are not persuasive for the following reason:

The Applicants reject the use of any earlier filing dates for Bresemann as it was filed as a CIP application, so material in Bresemann cited by the Office Action may not have the benefit of the earlier filing date.

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Examiner is providing the patent (6,748,515 to Hendrickson et al.) which issued from the parent application of which the Bresemann reference is a CIP as proof that the cited portions of Bresemann are in fact contained in the earlier filed, now patented, parent application (09/617,350, which issued as 6,748,515), thereby entitling the Bresemann reference to the benefit of the earlier filing date of the parent application and qualifying the cited portions of Bresemann as prior art against the claimed invention.

13. Applicant's remaining arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumati Lefkowitz whose telephone number is 571-272-3638. The examiner can normally be reached on Monday-Friday from 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached at 571-272-3632.

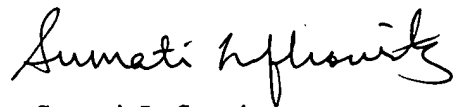
The fax phone numbers for the organization where this application or proceeding is assigned are:

703-872-9306 for Official communications

571-273-3638 for Unofficial/Draft/Courtesy communications

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

A handwritten signature in black ink, appearing to read "Sumati Lefkowitz". The signature is fluid and cursive, with a large, stylized initial 'S'.

Sumati Lefkowitz
Primary Examiner
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sl
January 4, 2005